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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/607,864	06/30/2000	Andrew Bencich Woodside	24760A	9951

22889 7590 11/30/2001

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EXAMINER	
NGUYEN, KIMBERLY T	
ART UNIT	**PAPER NUMBER**
1774	5

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/607,864	Applicant(s) WOODSIDE ET AL.	
	Examiner Kimberly Nguyen	Art Unit 1774	

-- The MAILING DATE of this communication app ars on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *1-14 and 28-30* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-30* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a composite article, classified in class 428, subclass 292.1.

II. Claims 15-27, drawn to a plurality of pellets, classified in class 428, subclass 407.

III. Claims 28-30, drawn to a method for making pellets, classified in class 427, subclass 58.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the composite article need not be made with the pellets, but instead, with the fibers and coatings alone which are not in pellet form. The subcombination has separate utility such as using the pellets in fabric or antiglare screen.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as laminating (i.e.

adhering) the polymer to the strands and kneading the strands into the polymers which have already been pre-cut to form the pellets.

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by a materially different process such as laminating (i.e. adhering) the polymer to the strands and kneading the strands into the polymers which have already been pre-cut to form the pellets.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Anthony R. Chi on November 14, 2001 a provisional election was made with traverse to prosecute the invention of Group II, claims 15-27. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-14 and 28-30 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Claim Objections

Claims 17, 24, and 26 are objected to because of the following informalities: Each claim needs to be punctuated with a period. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 17-18, 23, and 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Kosuga et al., U.S. Pat. No. 4,960,642.

Kosuga shows pellets for making electromagnetic wave shielding material comprising carbon conductive fibers (column 2, lines 26-27), an organic coating of a thermoplastic resin oligomer having a viscosity of not more than 10,000 centipoises when melted (column 1, lines 21-28 and claim 1), and a thermoplastic resin coating (polymer coating) (claim 1). Kosuga shows that the fibers have a length of 6mm (column 4, line 45). Kosuga further shows that the conductive fibers are bundled in groups of 1,000 to 10,000 (column 2, lines 30-32). Kosuga also shows that the thermoplastic resin coating comprises acrylonitrile-butadiene-styrene copolymer (claim 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 15, 16, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosuga et al., U.S. Pat. No. 4,960,642.

Kosuga is relied upon as above for claim 15.

Kosuga does not specifically show that the pellets are capable of being consolidated into a composite without the addition of any other material. However, "[E]ven though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). *See* MPEP §2113. Here, the pellets of Applicants' invention are the same as the pellets of Kosuga because both pellets are comprised of the same materials (i.e. conductive fibers, organic material coating, and polymer).

Though Kosuga shows that the organic thermoplastic resin oligomer material has a viscosity of no more than 10,000 centipoises when melted (claim 1), Kosuga does not show that

19-22

the pellets have such a viscosity at temperatures of from 80°C - 180°C as in instant claims 19-22. Kosuga uses the same organic thermoplastic resin oligomer materials as in Applicants' invention. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the an organic material which has a viscosity of no greater than 1500 centipoises at temperature ranges of 80°C - 180°C since it is known in the art that such oligomers would have those viscosities.

Claims 15 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosuga et al., U.S. Pat. No. 4,960,642 in view of Kobayashi et al., U.S. Pat. No. 4,356,228.

Kosuga is relied upon as above for claim 15.

Kosuga shows that the organic thermoplastic resin oligomers used to coat the conductive carbon fibers include polyester resins, ethylene-ethyleacrylate resins (claims 2-4). Kosuga does not show that the organic thermoplastic resin oligomers are comprised of those listed in instant claim 24.

Kobayashi shows a fiber-reinforced moldable sheet comprising a thermoplastic resin and reinforcing agents of carbon fibers incorporated into the thermoplastic resin (Abstract). Kobayashi shows that the thermoplastic resins used include polyesters (column 3, lines 64-68), poly(bisphenol A carbonate), polysulfones, styrene resins, and acrylic resins (column 4, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a bisphenol A resin in the organic thermoplastic resin oligomer coating of the present invention since bisphenol A, polyester, and acrylic resins are functional equivalents.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly Nguyen whose telephone number is (703) 308-8176. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (703) 308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-5408 for regular communications and (703) 305-3559 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Kimberly Nguyen
Examiner
Art Unit 1774
November 16, 2001

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700